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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,218	05/07/2002	Marcus Filshie	02597	2627

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,218

Applicant(s)

FILSHIE ET AL.

Examiner

Bradford C. Pantuck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment #1.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,846,255 to Casey in view of U.S. Patent No. 4,822,348 to Casey. Casey '255 discloses all of the structural features of the claimed invention, excepting that his liner is not made out of silicon rubber. Casey '255 discloses a surgical clip with upper jaw (12) and lower jaw (10), attached together at hinge (16/18) [Fig.]. The lower jaw has latching means (30), which engages with generally straight section (28) when the clip is closed [Column 3, lines 56-65; see Fig. 2B]. Lower jaw (10) has a "resilient cushioning material" (42) as a liner, but it is not specifically disclosed as being silicon rubber. The upper jaw (12) has a complex shape including a straight section (general area of part 22), and an arcuate shaped section (36) [see Attachment #1]. In Attachment #1, the straight section is striped, the first portion (larger radius of curvature) has circles, and the second portion has stars. The radius of curvature of the first portion is very clearly greater than the second portion; that is, the first portion curves more slightly than the second portion.

Casey '255 makes reference [see Column 1, lines 19-20] to his previous patent (U.S. 4,822,348), in which the liner is made specifically out of silicone rubber. In the

older patent, Casey teaches that there are different materials that are safe for implantation within the human body, one of them being silicone rubber. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to choose to make the lining out of silicone rubber (as opposed to other foams and rubbers), as a mere matter of design choice, as taught by Casey '348.

2. Regarding Claim 2, Casey '255 discloses generally straight section (28) [Fig. 1].
3. Regarding Claim 4, straight section 28 extends distally from latching means 30.
4. Regarding Claims 5 and 6, the first and second arcuate shaped portions (denoted respectively by circles and stars in Attachment #1) has the same width (laterally) along its length.
5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,418,694 to Beroff et al. in view of U.S. Patent No. 6,206,896 B1 to Howell et al. Beroff discloses a surgical clip for clamping blood vessels having upper jaw 11, lower jaw 12, and hinge 13. The upper jaw has straight section 23 and an arcuate shaped section including first portion 22 (larger radius of curvature) and second portion 10 (smaller radius of curvature). Beroff's clip is not lined with silicone rubber.

However, Howell discloses another clamp for closing blood vessels and teaches applying a cushioning silicone rubber pad to the inner sides of the jaws in order to "impart a cushioning effect upon the clamped vessel" [column 2, lines 42-44 and column 2, lines 30-31]. Therefore, it would have been obvious to one having ordinary skill in the art of surgical blood vessel clamping at the time of the invention

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to apply silicone rubber cushioning to the inner portions (16 and 18) of Beroff's jaws in order to cushion a blood vessel and preventing trauma, as taught by Howell et al.

6. Regarding Claim 3, the radius of curvature of bent portion 22 is on the order of 3 times bigger than the bent portion 10.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,726,372 to Perlin

U.S. Patent No. 5,160,339 to Chen et al.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Response to Arguments

9. Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive. Although Applicant has added a few phrases in attempt to distinguish from the prior art, Applicant has failed to differentiate his invention from that of U.S. Patent No. 5,846,255 to Casey in view of U.S. Patent No. 4,822,348 to Casey. In particular, Examiner would like to comment on Applicant's statement made in "REMARKS," p. 5 of 6, lines 8-10:

"In the '255 patent the outer surface where the reference character 12 points to in Fig. 1 is absolutely straight and has no arcuate portion thereto."

Although the above statement is true, in the claims Applicant sets forth *not the above statement, but rather:*

"...said first arcuate shaped portion having a first radius of curvature on at least its outer contact surface that is substantially greater than the radius of curvature of said second arcuate shaped portion which has a second radius of curvature."

That is, the differentiation Applicant is making is that the *radius of curvature* of the outer surface of the *first* arcuate section is larger than the radius of curvature of the *second* arcuate section. U.S. Patent No. 5,846,255 to Casey in view of U.S. Patent No. 4,822,348 to Casey meets this limitation. Although Applicant is correct in pointing out that the outer surface of member 36 is flat, the member 36 taken as a whole can accurately be described as arcuate shaped since its lower surface is curved, and the average curvature of the whole beam (i.e. the center line) is slightly curved.

Regardless, the outer surface of member 12 is not curved, but is a flat surface. Examiner contends, however, that *the radius of curvature of a straight line is infinite*, as

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evidenced by "The History of Curvature, page 4 of 7, last paragraph, lines 3 and 4. Therefore, the radius of curvature of the starred section [see Attachment #1 attached hereto] is less than the radius of curvature of the section having circles drawn therein, because the radius of curvature of the outer surface of the section having circles drawn therein is *infinite*.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C. Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP
June 22, 2005


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

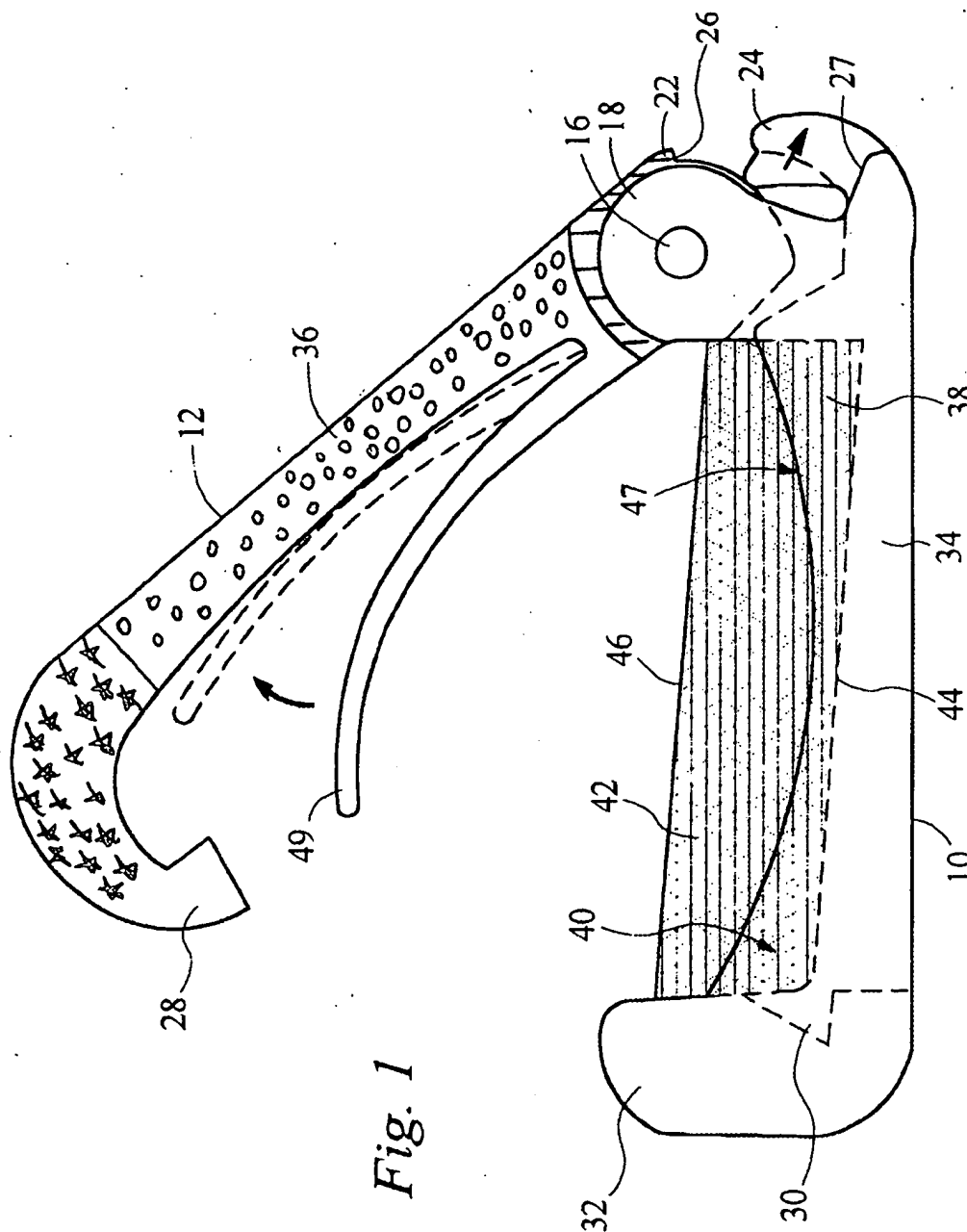



Fig. 1